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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,592	06/29/2004	Clemens Suerbaum	2002P01232WOUS	4736

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Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, NJ 08830

EXAMINER

HESS, DANIEL A

ART UNIT	PAPER NUMBER
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2876

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/500,592

Applicant(s)

SUERBAUM, CLEMENS

Examiner

Daniel A. Hess

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 06/29/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to Applicant's filing of 6/29/04, which has been entered into the electronic file of record.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 17 and by extension claims 18-31 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the step of presenting to each user at the time that communications between the two users is initiated a plurality of choices representing different possible communications parameters to be used and the step of receiving each user's chosen preferences of communication parameters.

Claim 32 and by extension claims 33-36 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: a unit which presents to each user at the time that communications between the two users is initiated a plurality of choices representing different possible communications parameters to be used and a unit which receives each user's chosen preferences of communication parameters.

Art Unit: 2876

The Examiner notes that the primary art being applied below relates to the much broader circumstance of a cellular industry association voting on standards to be adopted for communications. The fact that this art is applicable although it is quite different from the embodiments in the specification demonstrates the over-broadness of the independent claims as presently recited. If amended as suggested above, the prior art applied below would not be applicable.

The claims as written do not convey that the vote is part of a single instance of communication between two users in real time.

Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim language 'determining the maximum number of parameters that can be used as the minimum number of parameters that can be used' appears self-contradictory.

Claim 25 recites the limitations 'lowest or highest mode.' There is insufficient antecedent basis for this limitation in the claim, because the meaning of 'mode' has not been established in the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by the article “Comparison of Wireless Standards-Setting” by Tan, dated 09/2001.

Re claims 17 and 18: In section 3.1, Tan writes, “Starting from 1985, CTIA (Cellular Telephone Industry Association) launched a systematic evaluation of various technological alternatives. This was endorsed by cellular operators and major equipment manufacturers including Motorola, AT&T, Nortel, Ericsson, and IMM. TDMA, CDMA, N-AMPS, and E-TDMA were among the candidates. In 1989, CTIA members voted TDMA as the standard for the 2G mobile systems mainly based on its commercial readiness and availability.”

Here CTIA members can be considered ‘users’ since there must be communication between members, i.e. Motorola must be able to communicate with Nortel etc. The members voted on different standards and adopted a particular standard. As standard involves a set of parameters used for transmitting data.

A decision unit is extremely broad and could even include a ballot box or computer receiving the votes of CTIA members, or a desk at which the votes are tallied.

Art Unit: 2876

Re claim 19: The term 'functionality' is very broad and the claim does not list specific ones. Each of the protocol candidates TDMA, CDMA, N-AMPS, and E-TDMA etc. can be considered to represent different 'functionality.'

Re claim 20: The protocol chosen above is also a data format.

Re claim 24: Some sequence had to be used for voting on the various possible parameters.

Re claim 29: A decision unit can simply be a ballot.

Re claim 30: The limit of claim is met if the decision unit is considered to be whatever is used to tabulate the votes.

Re claim 31: Clearly when the CTIA elected a standard, they decided for all users.

Re claim 32: See discussion re claim 17, above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tan.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the largest member of CTIA to have the greatest influence in selection of parameters.

Allowable Subject Matter

In the Examiner's view, the claims could be allowable if amended as the Examiner has suggested to overcome the 112 rejections of claims 17 and 32 as omitting essential elements and method steps.

Conclusion

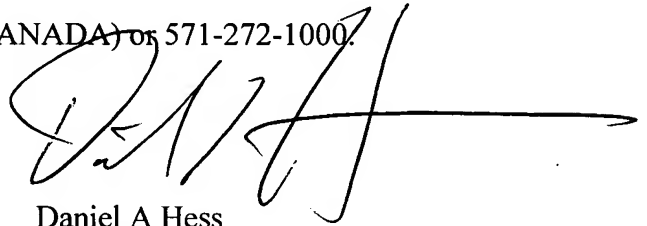
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Baumhauer, Jr. et al. (US 5,506,908) teaches voting in a communications context, but it is automatic voting, not by users.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A. Hess whose telephone number is (571) 272-2392. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2876

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'D. A. Hess', with a long horizontal stroke extending to the right.

Daniel A Hess
Examiner
Art Unit 2876

2/23/2007